

REMARKS**Summary of the Office Action**

Claims 1 and 7 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly being non-enabled.

Claims 1, 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,875,164 to Yamakawa et al. ("Yamakawa") in view of U.S. Patent No. 6,041,031 to Ichimura et al. ("Ichimura"), European Patent Application No. 0 814 465 ("EP '465"), and U.S. Patent No. 5,993,930 to Hector et al. ("Hector").

Claims 1, 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,031,792 to Nakano et al. ("Nakano") in view of either Narahara et al. ("Narahara") or Ichimura, and further in view of EP '465 and Hector.

Summary of the Response to the Office Action

Applicants have canceled claim 8 without prejudice or disclaimer.

Applicants have amended claim 1.

Claims 1 and 7 are pending.

All Claims Define Allowable Subject Matter

Claims 1 and 7 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly being non-enabled. Applicants respectfully traverse the rejection under 35 U.S.C. § 112, first paragraph. Applicants have amended claim 1 to address the Examiner's concern described at

paragraph 1 of the Office Action. Applicants request that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

Claims 1, 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamakawa in view of Ichimura, EP '465, and Hector. Claims 1, 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakano in view of either Narahara or Ichimura, and further in view of EP '465 and Hector. Applicants have canceled claim 8 without prejudice or disclaimer rendering the rejections of claim 8 moot. Applicants respectfully traverse the rejections under 35 U.S.C. § 103(a), of claims 1 and 7, for at least the following three reasons:

First, Applicants respectfully submit that in each of the rejections under 35 U.S.C. § 103(a), the Office Action has pieced together four references to teach the claimed features. However, MPEP § 2143.01 instructs that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990).” MPEP § 2143.01 further instructs that “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” Applicants respectfully submit that the references do not provide such a suggestion or motivation.

Applicants respectfully submit that the only motivation to piece together the four references of the Office Action is found in the Applicants’ own application. MPEP § 2141 instructs that “the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.” MPEP 2143 instructs that “the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found

in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ 1438 (Fed. Cir. 1991)." The Federal Circuit has clearly held that "the motivation to combine references cannot come from the invention itself." Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ 2d 1377 (Fed. Cir. 1993). Thus, Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness.

Second, the Office Action relies on Hector to show the feature of "each of said spacer layers of the multi-layered recording medium has a thickness of 10 μm to 30 μm ," as recited in independent claim 1. Referring to col. 3, lines 14-21, the multi-layered medium of Hector is read by an optical player having a numerical aperture of 0.4-0.6. In contrast, the pickup device recited in claim 1 recites an objective lens having a numerical aperture of 0.85 or greater. The embodiment of Applicants' invention recited in claim 1 includes an objective lens having a high numerical aperture NA of 0.85 or greater in order to record and reproduce information to and from a high density multi-layered recording medium. Applicants submit that, although a portion of the Hector spacer layer thickness overlaps the claimed values, one of ordinary skill in the art would not look to Hector for a spacer layer thickness to include in a device having different conditions, *i.e.* a numerical aperture of 0.85 or greater.

Third, Applicants have amended claim 1 to provide a different recitation relating to Applicants' invention. Claim 1 recites the photodetector has a normalized detector size (B/β^2) of a size of 10 μm^2 to 50 μm^2 based on a predetermined focus-servo capture range and interlayer crosstalk. Support for claim 1 is provided at, for example, page 11, lines 8-11, of Applicants' specification as originally filed. Applicants respectfully submit that even if the applied references could be combined, a proposition with which Applicants disagree, none of the applied

references teach or suggest the feature of a normalized detector size (B/β^2) of the claimed range being based on a predetermined focus-servo capture range and interlayer crosstalk. Claim 7 depends from claim 1, and recites the same combination of allowable features recited in claim 1, as well as additional features that define over the prior art. Accordingly, it is requested that the rejections under 35 U.S.C. § 103(a), of claims 1 and 7, be withdrawn and the claims allowed.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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